

REMARKS**Summary of the Office Action**

In the Office Action, claim 1 and the specification are objected to for certain informalities. Claims 1, 3, and 13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Claims 1 and 3 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,465,733 to *Hinohara et al.* (“*Hinohara*”) in view of U.S. Patent No. 5,409,470 to *Stoy et al.* (“*Stoy*”).

Claim 13 is indicated as allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph, and to include all the limitations of the base claim and any intervening claims.

Summary of the Response to the Office Action

Applicants propose amending claims 1, 3, and 13 to better clarify the invention. Accordingly, claims 1, 3, and 13 are pending for further consideration.

Specification

The specification has been amended to correct for typographical errors. However, the Applicants respectfully submit that the number “3” already follows “ellipsoidal helical spring 3” on page 8, line 2, and further, that there is no page 23 of the specification.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 1, 3, and 13 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Claims 1, 3, and 13 have been amended to correct the ambiguities alleged in the

Office Action. Applicants respectfully submit that independent claims 1, 3, and 13 are in full compliance with 35 U.S.C. § 112, second paragraph. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Claims are Allowable

Claims 1 and 3 stand rejected under 35 U.S.C § 103(a) as allegedly being unpatentable over *Hinohara* in view of *Stoy*. This rejection is respectfully traversed.

Hinohara shows a guide wire for use with cardiovascular catheters. The guide wire has a solid core at the proximal end and is tapered at the distal end and is surrounded by a coil spring. See the Abstract of *Hinohara*.

Stoy discloses a method of making a radio-opaque tipped, sleeved guide wire that has a bendable core piece of a predetermined length. The guide wire has a control end and the distal end, and has a predetermined core diameter. The method of *Stoy* provides a shrinkable volumetric sleeve formed of the first polymer composition having a first diameter at least as large as the core diameter and having a second, smaller diameter from shrinking said second diameter, which is less than said core diameter. See Abstract of *Stoy*.

To establish a prima facie case of obviousness, three basic criteria must be met by the references (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations. Applicants respectfully submit that the references cited in the current Office Action fail to meet the criteria.

Neither *Hinohara* nor *Stoy*, either alone or in combination, teach or suggest at least the features of “a front end of the balloon catheter is diametrically smaller than a maximum diameter of the mirror-finished barrel portion, and elastically deforms to be diametrically greater than a tube portion of the balloon catheter so as to be a flared end portion when the mirror-finished barrel portion engages with the front end of the balloon catheter in accompany with provisionally connecting the balloon catheter,” as recited in amended independent claim 1. Emphasis added.

Moreover, neither *Hinohara* nor *Stoy* teaches or suggests that a balloon catheter engages a guide wire. Fig. 3 of *Hinohara* merely shows the balloon catheter and guide wire are abutting each other. The plain and ordinary meaning of the word engages suggests that the balloon catheter and the barrel portion must be interlocked together to be engaged. *Hinohara* does not teach or suggest this feature.

Hinohara shows in Fig. 5 that the distal end of the tubular catheter does not flare outwardly when the catheter is encountered with the guide wire. This is evident from the fact that the tubular catheter has a rounded portion at its outer side as shown in Fig. 4, and has a reverse tapered configuration at its outer side as shown in Fig. 6 of *Hinohara*.

Stoy fails to cure the deficiencies identified in *Hinohara*, and as such neither reference can make obvious the present invention. *Stoy* does not show or describe a guide wire engaging a balloon catheter at all.

As previously mentioned, none of the applied references teach or suggest the “the mirror-finished barrel portion engages with the front end of the balloon catheter.” As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180

USPQ 580 (CCPA 1974). Thus, the Office Action fails to establish a *prima facie* case of obviousness at least because it does not teach all of the recited claim features. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 103(a) should be withdrawn because neither *Hinohara* nor *Stoy* teaches or suggests each feature of independent claim 1.

In view of the above arguments, Applicants respectfully request that the rejection of independent claim 1 under 35 U.S.C. § 103 be withdrawn. Additionally, claims 3 and 13, which depend from independent claim 1, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.

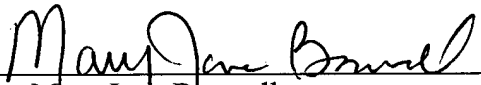
CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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